

REMARKS

Introductory Comments

The present application as appealed included claims 1-4, 6-10 and 22. Claims 5, 11-21 and 23-27 were previously cancelled. With this amendment, Applicant amends claims 1 and 8; cancels claims 6 and 7; and adds new claims 28-43 as indicated in the Listing of the Claims. Thus, with this Amendment, claims 1-4, 8-10, 22 and 28-43 are pending in the present application. Continued examination of the application, as amended, and in view of the decision of the Board of Patent Appeals and Interferences and the following remarks, is respectfully requested.

Decision by the Board of Patent Appeals and Interferences

The Board sustained the Examiner's rejection of claims 1, 8-10 and 22 under 35 USC §102, and the rejection of claims 2-4 and 7 under 35 USC §103. (see Decision, page 7)

The Board did not make a decision regarding claim 6 because it found there was no outstanding rejection thereof in the record before them. (See Decision, page 1)

Rejections under 35 U.S.C. § 102(b)

Claims 1, 8-10 and 22 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,976,082 to Wong et al. ("Wong"). Applicant has amended independent claim 1 to recite additional limitations distinguishing over Wong including the limitations of former claim 6.

Amended claim 1 recites "collecting self-reported information from an individual about their perceived health for a predetermined set of predictive factors." In contrast, Wong teaches using health care claims billing records to obtain information about an individual (Wong, col. 3, lines 58- col. 4, line 4). Claims records are not "self reported information from an individual about their perceived health" as recited in amended claim 1. Firstly,

claims records are retrieved from a benefits or health care provider as opposed to being “self reported information from an individual.” Secondly, claims records do not provide “information from an individual about their perceived health” as recited in claim 1. Claims records are objective billing information about procedures or services received from the healthcare system for an individual provided by a benefits or health care provider as opposed to more subjective information about “perceived health” provided by the individual.

In addition, amended claim 1 recites “for each said distinct predictive factor of said predetermined set of predictive factors: . . . ; assigning. . . a first dichotomous value to said separate value for said distinct predictive factor if . . . said distinct predictive factor is indicative of said high risk . . . ; and assigning . . . a second dichotomous value to said separate value for said distinct predictive factor if . . . said distinct predictive factor is not indicative of said high risk . . . ” Wong discloses using some yes/no values for its independent variables of interest in Table 1 (Wong, col. 12, line 46 – col. 13, line 18). However, Wong uses many independent variables that are not dichotomous variables such as number of various events (see variables 11-20 of Table 1) and costs (see variables 21-23 of Table 1). In contrast, claim 1 recites that a dichotomous value is assigned to “each said distinct predictive factor of said predetermined set of predictive factors,” not just a subset of the predictive factors as in Wong.

For at least the reasons given above claim 1 is believed to be patentable over Wong. Claims 8-10 and 22 are dependent on base claim 1 and include additional potentially patentably distinguishing features. Accordingly, Applicants respectfully request that the Examiner find claims 1, 8-10 and 22 allowable over Wong.

Rejections under 35 U.S.C. § 103(a)

Claims 2 and 3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wong in view of U.S. Patent No. 5,486,999 to Mebane (“Mebane”). As described above, Applicant has amended independent claim 1 to recite additional limitations distinguishing over Wong. Claims 2 and 3 depend from claim 1. Applicant respectfully submits that the amendments to claim 1 also distinguish over Mebane.

As described above, amended claim 1 recites “for each said distinct predictive factor of said predetermined set of predictive factors: . . . ; assigning . . . a first dichotomous value to said separate value for said distinct predictive factor if . . . said distinct predictive factor is indicative of said high risk . . . ; and assigning . . . a second dichotomous value to said separate value for said distinct predictive factor if . . . said distinct predictive factor is not indicative of said high risk . . . ” As discussed above, Wong teaches using many independent variables that are not dichotomous variables such as number of various events (see variables 11-20 of Table 1) and costs (see variables 21-23 of Table 1). Mebane also discloses using many input vector variables in Table 1 (Mebane, col. 6, lines 30-48). Table 1 of Mebane shows that variables 1-18 are not dichotomous variables and this is reinforced by the description of these variables (see Mebane, col. 36, line 36 – col. 9, line 39). In contrast, claim 1 recites that a dichotomous value is assigned to “each said distinct predictive factor of said predetermined set of predictive factors,” not just a subset of the predictive factors. Neither Wong nor Mebane, either alone or in combination, teach assigning a dichotomous value to each predictive factor as recited in claim 1.

For at least these reasons claim 1 is believed to be patentable over Wong in view of Mebane. Claims 2 and 3 are dependent on base claim 1. Accordingly, Applicants respectfully request that the Examiner find claims 2 and 3 allowable over Wong in view of Mebane.

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Wong in view of U.S. Patent No. 6,269,339 to Silver (“Silver”). As described above, Applicant has amended independent claim 1 to recite additional limitations distinguishing over Wong.

Claim 4 is dependent on base claim 1. Applicant respectfully submits that the amendments to claim 1 described above also distinguish over Silver. For at least these reasons, Applicants submit that claim 4, which is dependent on claim 1 is patentable over Wong in view of Silver. Accordingly, Applicants respectfully request that the Examiner find claim 4 allowable over Wong in view of Silver.

New Claims 28-43

New claim 28 is dependent on amended claim 1 which is believed to be allowable. For at least this reason, Applicants respectfully request that the Examiner find claim 28 allowable.

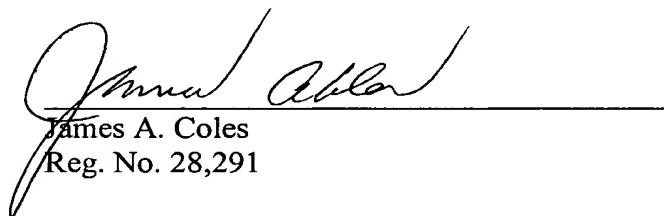
New claims 29-43 include two independent claims, 29 and 39. Claims 30-38 are dependent on base claim 29, and claims 40-43 are dependent on base claim 39. Each of claims 29 and 39 are believed to be patentable over the prior art. Claims 30-38 and 40-43 are believed to be patentable and to add further patentably distinguishing features. Accordingly, Applicants respectfully request that the Examiner find claims 29-43 allowable.

Final Remarks

Claims 1-4, 8-10, 22 and 28-43 are believed to be in condition for allowance. Such allowance is respectfully requested.

If necessary, please consider this a Petition for Extension of Time to effect a timely response. Please charge any additional fees or credits to the account of Bose McKinney & Evans, LLP Deposit Account No. 02-3223. In the event that there are any questions related to these amendments or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned.

Respectfully submitted,
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